

PATENT COOPERATION TREATY

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From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

WRITTEN OPINION OF THE
INTERNATIONAL PRELIMINARY
EXAMINING AUTHORITY
(PCT Rule 66)

To:

Hepp et al.
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Date of mailing
(day/month/year) 12.10.2005

Applicant's or agent's file reference
PSIC076WO

REPLY DUE within 1 month(s)
from the above date of mailing

International application No. PCT/EP2004/005391	International filing date (day/month/year) 19.05.2004	Priority date (day/month/year) 02.07.2003
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International Patent Classification (IPC) or both national classification and IPC
G01F1/704

Applicant
SICPA HOLDING S.A. et al.

1. ☐ The written opinion established by the International Searching Authority:
☐ is ☒ is not
considered to be a written opinion of the International Preliminary Examining Authority
2. This first report contains indications relating to the following items:
☒ Box No. I Basis of the opinion
☐ Box No. II Priority
☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
☐ Box No. IV Lack of unity of invention
☒ Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step and industrial applicability; citations and explanations supporting such statement
☐ Box No. VI Certain documents cited
☐ Box No. VII Certain defects in the international application
☒ Box No. VIII Certain observations on the international application

Blau: 28.10.05
Rot: 11.11.05

3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(e).


How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3.

Also: For the form and the language of the amendments, see Rules 66.5 and 66.8.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4bis.
For an informal communication with the examiner, see Rule 66.6.
For an additional opportunity to submit amendments, see Rule 66.4.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary report on patentability (Chapter II of the PCT) must be established according to Rule 69.2 is: 02.11.2005

Name and mailing address of the international
preliminary examining authority:

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**WRITTEN OPINION OF THE INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY**

International application No.
PCT/EP2004/005391

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This opinion is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the International application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements** of the International application, this opinion is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed")*:

Description, Pages

1-31 as originally filed

Claims, Numbers

1-17 as originally filed

Drawings, Sheets

1/2, 2/2 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify)*:
 - ☐ any table(s) related to sequence listing *(specify)*:
4. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing *(specify)*:
 - ☐ any table(s) related to sequence listing *(specify)*:

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Box No. V Reasoned statement under Rule 66.2(a)(II) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	9,11-13
	No: Claims	1-8,10,14-17
Inventive step (IS)	Yes: Claims	
	No: Claims	1-17
Industrial applicability (IA)	Yes: Claims	1-17
	No: Claims	

2. Citations and explanations:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

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Reference is made to the following documents:

- D3: DE 199 01 041 A (KERNFORSCHUNGSANLAGE JUELICH) 27 July 2000 (2000-07-27)
D4: US-A-3 894 917 (RISEMAN JOHN H ET AL) 15 July 1975 (1975-07-15)

The document **D10** was not cited in the international search report. A copy of the document is appended hereto.

D10: US-A-5,849,590

Re Item VIII

Reasoned statement with regard to clarity

claim 2: Claim 2 includes all the features of claim 1. Hence, claim 2 should be reformulated as a claim dependent on claim 1, cf. Rule 29(4) EPC and the Guidelines C-III, 3.5.

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

- 1 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1 and 17 is not new in the sense of Article 33(2) PCT.

claim 1:

D10 discloses a method for marking a material (explosive material), the method comprising the steps of:

- identifying at least one ion (col. 9, l. 2-42) comprised in the said material at a concentration level of below 50 ppm in the unmarked state (col. 8, l. 13-35 state

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- that the marker concentration of a selection of rare elements in natural abundance is between 0.001 ppm and 40 ppm)
- selecting a marking composition comprising at least one ion as identified in step 1
 - incorporating the marking composition of step 2 into the said unmarked material (abstract; col. 7, l. 39- col. 10, l. 22)

wherein the concentration level of the said at least one ion in the marked material is increased in step 3 by at least the factor of 3 as compared to the concentration level of the ion present in the unmarked material (col. 9, l. 37-42)

claim 17:

For reasons analogous to those given for claim 1, the subject-matter of independent claim 17 is not new either (col. 4, l. 26: tagging of foodstuff/grain).

- 2 Varioups dependent claims do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step, see documents D3,D4,D10 and the corresponding passages cited in the search report.

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|---------------|------|--|
| claim 2: | D10: | (col. 10, l. 16-22) |
| claim 3: | D10: | concentration of rare elements is known (col. 8, l. 8-25) |
| claims 4-8: | D10: | (col. 8, l. 5-34; col. 9, l. 23-42) |
| claim 9: | D10: | (col. 4, l. 26: tagging of foodstuff/grain). Subject-matter not inventive; the spilled shipments could also be drugs or pharmaceutical products etc. |
| claim 10: | D10: | (col. 7, l. 12-22) |
| claim 11-13: | | Not inventive; analysis in D10 can be performed by a wider variety of techniques (e.g. D3, D4) |
| claim 14: | D10: | (col. 10, l. 16-22) |
| claims 15-16: | D10: | (col. 10, l. 16-22) |